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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,273	01/16/2002	Stephen F. Gass	SDT 320	7228
27630	7590	02/06/2004	EXAMINER	
SD3, LLC 22409 S.W. NEWLAND ROAD WILSONVILLE, OR 97070			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,273

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

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JH

-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention. It should further be noted that rejections under 35 U.S.C 102(a) and 102(e) using the same U.S. Patent Applications/Publications have not been made because they do qualify as prior art as their filing dates are not before the filing date of the instant application.

Additionally, it should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, Applicant's help in determining all appropriate double patenting rejections with all of Applicant's applications is requested because of the large number of similar applications.

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 120 and 119(e). See 37 CFR 1.78.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

2. Even if a copending application is listed as a parent to the instant application and material information is technically of record in one or more parent applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

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Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56 is cited here:

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney, or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9 of copending Application No. 10/100,211, U.S. Patent Application Publication 2002/0170399. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9 of copending Application No. 10/100,211, U.S. Patent 2002/0170399, as applied to claim 1 above and further in view of the following.

Claims 2-9 of co-pending application '211 discloses the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the application '211 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held

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that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

6. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/052,806, U.S. Patent Application Publication 2002/0059855. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/051,782, U.S. Patent Application Publication 2002/0066346. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of

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copending Application No. 10/051,782, U.S. Patent 2002/0066346, as applied to claim 1 above and further in view of the following.

Claims 1-20 of co-pending application '782 disclose the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the application '782 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

9. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent Application Publication 2002/0017179. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent 2002/0017179, as applied to claim 1 above and further in view of the following.

Claims 1-29 of co-pending application '238 disclose the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the application '238 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

11. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/047,066, U.S. Patent Application Publication 2002/0056348. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/047,066, U.S. Patent 2002/0056348, as applied to claim 1 above and further in view of the following.

Claims 1-20 of co-pending application '066 disclose the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the application '066 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

13. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/050,085, U.S. Patent Application Publication 2002/0056349. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/050,085, U.S. Patent 2002/0056349, as applied to claim 1 above and further in view of the following.

Claims 1-20 of co-pending application '085 disclose the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the application '085 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

15. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of

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copending Application No. 09/929,242, U.S. Patent Application Publication

2002/0017181 in view of Bosten et al. or Meredith et al.

Claims 1-18 of copending application '242 discloses the claimed invention substantially as claimed except that a woodworking tool is claimed instead of a miter saw; however, Bosten et al. and Meredith et al. both discloses that it is old and well known in the art to use miter saws as woodworking tools for the purpose of cutting crown molding at angles for increased efficiency. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the device as claimed in claims 1-18 of '242 with a miter saw in order to safety cut molding at an angled.

As to claim 2, the modified device of application '242 disclose the invention substantially, as explained above but lacks the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the modified device of application '242 urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

Comments on Commonly Assigned Applications

16. Claims 1-15 are directed to an invention not patentably distinct from the claims, see above, of commonly assigned applications, for the reasons stated above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned applications, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

18. Claims 1-15 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is not clear who actually invented the subject matter of claims 1-15 because the above co-pending applications have different inventive entities. Therefore, it is not clear which portion of the applications where invention by the same inventive entity of the instant application.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosten et al., U.S. Patent 5,285,708, or Meredith, U.S. Patent 5,724,875, in view of Lokey, U.S. Patent 3,785,230, and Terauchi, U.S. Patent 4,512,224.

Bosten et al. and Meredith et al. both disclose the invention substantially as claimed except for the detection system and the reaction system; but includes, e.g., a base assembly (16/18 or 12/14) defining a cutting zone (see Figure 1); a pivot arm (28 or 16/36) coupled to the base assembly and selectively moveable toward and away

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from the cutting zone; a motor assembly (34 or 22); a rotatable arbor (152 or 44) supported by the pivot arm and driven by the motor assembly; a rotatable blade (36 or 18) mounted on the arbor and configured to cut workpieces supported with the cutting zone. The detection system is configured to detect a dangerous condition between a person and the blade. The reaction system is configured to urge the pivot arm away from the base assembly upon detection by the detection systems of the one or more dangerous conditions.

Lokey discloses that it is old and well known in the art to use detection and braking system for the purpose of preventing injury to a user, wherein the brake systems of Lokey is located on the front of the guard of the rotating saw such that angular momentum of the blade is transferred to the blade housing upon activation of the brake. The braking system of Lokey also includes pawls to engage the blade.

Terauchi discloses that it is old and well known in the art to use safety systems that includes immediate stopping of the blade and/or retraction of the a blade when the blade contacts a workpiece holder for the purpose of preventing damage or further damage to the workpiece holder.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and a braking system, as taught by Lokey and Terauchi with the devices of Bosten et al. or Meredith et al. such that the pivot arm is urged away from the base assembly upon detection of a dangerous condition in order to prevent injury to the user by retracting the blade upon detection of a dangerous condition.

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As to claim 2, the modified devices of Bosten et al. and Meredith et al. disclose the invention substantially as explained above but lack the specific distance that the pivot arm is urged away, more specifically at least one-eighth of an inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pivot arm of the modified devices of Bosten et al. and Meredith et al. urged away at least 1/8 of an inch or whatever distance for the purpose of ensuring the safety of the user, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

As to claim 3, the modified devices of Bosten et al. and Meredith et al. are configured to stop the rotation of the blade.

As to claim 4, the modified devices of Bosten et al. and Meredith et al. both disclose the use of tilt mechanism between the base assembly and the pivot arm (the pivot joint), hence their use for creating miter cuts in a workpiece.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
January 11, 2004